

Remarks

The Final Office Action dated July 11, 2006, indicated that claims 1-6, 8-16, 21, 23-28, 30, 32-36, 42-49, 51, 53-59, 63-66, 68, 70 and 74 stand rejected under 35 U.S.C. § 103(a) over Hamlin (U.S. Patent No. 5,574,964) in view of Ellis *et al.* (U.S. Patent Publication No. 2005/0251827); claims 20 and 50 stand rejected under 35 U.S.C. § 103(a) over Hamlin in view of Ellis *et al.* and further in view of Goldstein (U.S. Patent No. 5,410,326); claims 7, 22, 29, 31, 37-41, 67 and 75 stand rejected under 35 U.S.C. § 103(a) over Hamlin in view of Ellis *et al.* and in further view of Edens *et al.* (U.S. Patent No. 6,611,537); claims 17-19, 52 and 60-62 stand rejected under 35 U.S.C. § 103(a) over Hamlin in view of Ellis *et al.* and in further view of Cohen *et al.* (U.S. Patent No. 4,837,798); and claims 69 and 71-73 stand rejected under 35 U.S.C. § 103(a) over Hamlin in view of Ellis *et al.* and in further view of Lewis (U.S. Patent No. 5,835,126).

In addition to the above, the Final Office Action indicates (at page 4) a heading “Claim Objections” under which claim 3 is discussed, but no specific objection appears to be made. The Final Office Action alleges an antecedent basis issue, suggesting that “the plurality of appliances” has insufficient antecedent basis in referring to a “plurality of telephony-based appliances.” Applicant respectfully traverses any such objection because antecedent basis in the context of Section 112 or otherwise does not require word-for-word correspondence; rather, where the scope of a claim would be reasonably ascertainable by those skilled in the art, the claim is not indefinite. In this instance, the language in claim 3 referring to appliances as referred to in an earlier claim also referencing the appliances would be ascertainable by those skilled in the art. In this regard, Applicant submits that any objection to claim 3 would be improper.

Applicant respectfully traverses each of the Section 103 rejections because the Office Action fails to present a *prima facie* case of obviousness; the rejections fail to cite teaching or suggestion of all of the claimed limitations and further fail to provide motivation for combining the Ellis reference with the primary Hamlin reference. As all claim rejections rely upon this improper combination of Ellis with Hamlin, Applicant submits that all Section 103 rejections are improper and should be removed.

Regarding the rejection of the independent claims, the cited combination of references fails to teach or suggest limitations directed to a data memory circuit that stores packet-based data (or external-services data). As indicated in the Final Office Action, the primary Hamlin reference “does not teach that external services data can be stored in a data memory circuit.” In an effort to arrive at the claimed limitations, the Examiner suggests adding a “server 80” from the Ellis reference to the Hamlin reference. However, this proposed combination of Ellis’s server with the Hamlin reference does not teach or suggest the claimed data memory circuit because neither the server in the Ellis reference nor the database in the Hamlin reference stores external services data. In addition, the Final Office Action’s assertion that the Ellis reference “may be capable of handling text, graphics and video” falls short of showing any teaching or suggestion of claimed limitations directed to the claimed storage and distribution of data. The cited references therefore fail to teach, suggest or comprehend the storage of external services data as claimed. In this regard, the proposed combination of references does not establish a *prima facie* case of obviousness and the Section 103(a) rejections should be removed.

Applicant further traverses each of the Section 103(a) rejections because the Final Office Action fails to present any evidence of motivation for making the asserted modifications. Obviousness cannot be established by combining teachings of the prior art to produce a claimed invention absent some teaching, suggestion, or incentive supporting the combination. *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987). A claim rejection is proper only when there is something in the prior art as a whole to suggest the desirability, and thus, the obviousness, of making the combination. *In re Rouffett*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). In this instance, the Final Office Action’s suggestion that it would have been obvious to modify Hamlin with Ellis’ server “to use a typical client-server architecture in the home for storing and serving video and other data to devices in the home” is unsupported by any evidence from the prior art and fails to provide any rationale for modifying Hamlin. That is, the Final Office Action does not cite evidence that explains why one of skill in the art, when viewing the Ellis and Hamlin reference, would be motivated to store and serve video as neither of the references teach or suggest such an approach or the storage of any external-services data. Without a presentation of evidence

that would lead a skilled artisan to make the proposed modification, there is no *prima facie* case of obviousness the Section 103(a) rejections should be removed.

The following discussion addresses the Response to Arguments in the Final Office Action in an effort to clarify any misunderstanding as to the teachings of the Hamlin reference, the proposed modification of these teachings, and Applicant's prior remarks concerning the same. Specifically, page 2 of the Final Office Action cites Applicant's arguments concerning the prior Office Action's suggestion that a skilled artisan would provide caller ID information to television receiving units 46 of the Hamlin reference. The Response indicates that the Examiner disagrees with the Applicant, but the rationale provided in alleged support of this disagreement does not pertain to the issue at hand, namely, to providing caller ID information to television receiving units. Instead, the Examiner describes an interpretation that telephony is "the science of transmitting voice, data, video or image signals" and cites several paragraphs from the Hamlin reference that discuss the multitude of available communications mediums and their home use, and an approach to providing such communications over a common signal distribution system 10. In his discussion, however, there is no citation to any teaching, suggestion or motivation for displaying a caller ID on a television.

In short, it appears that the Answer is attempting to suggest that Hamlin somehow teaches that the various appliances coupled to the system 10 may use any data on the bus signal 80, even where that data is meant for other appliances, simply because different communication signals are passed on the bus signal 80. More particularly, the Examiner appears to be suggesting that the television 46 not only receives telephony information via the bus signal 80, but that the television 46 is somehow capable of processing the telephony information and displaying caller ID information. As discussed with Applicant's previous arguments, this suggestion is contrary to the purpose of the Hamlin reference relating to the user of a common bus for different types of appliances.

While routing the signals over a common bus, the Hamlin's purpose is to use the common bus while maintaining the delivery of each separate signal to an appropriate appliance, and without necessarily requiring any special equipment at or configuration of the appliances (*see, e.g.*, column 4, lines 23-26). Specifically as discussed at column 2, lines 8-25, Hamlin "converts each of the distinct input signals into a separate converted

frequency signal which becomes a component of a common bus signal.” The bus signal is passed on the distribution system 10 to pods at a receiving unit (*e.g.*, a television) that receive the common bus signal and transmit one of the separate converted frequency signals to an appropriate receiving unit (*see id.*). With this approach, Hamlin would apparently pass a telephone signal by converting the signal to a separate converted frequency signal that is added to a bus signal. The bus signal is received by a pod connected to a telephone, and that pod then extracts the separate converted frequency signal that corresponds to the telephone signal, and passes that signal to the telephone. In this regard, the proposed modification of Hamlin for routing a telephone signal for use by a television, much less for displaying caller ID information at the television (and any corresponding configuration of the television), is contrary to Hamlin’s purpose. Therefore, the Hamlin reference further fails to teach or suggest the claimed telephony limitations as asserted, and the proposed modification of Hamlin is contrary to its purpose. The Section 103 rejections relying upon the Examiner’s misplaced rationale are thus improper and should also be removed for these reasons.

In view of the above, the rejections of the independent claims are improper and should be removed. Furthermore, where an independent claim is nonobvious under 35 U.S.C. 103, any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). In this regard, Applicant submits that the rejections of all of the dependent claims should also be removed. Applicant further submits that additional discussion of improprieties with other claim rejections is unnecessary. However, Applicant reserves the right to address these further rejections, should any claim rejections be maintained.

In addition to the above, Applicant further submits that the Final Office Action fails to address and answer Applicant’s traversals in a manner consistent with M.P.E.P. §707.07(f), and that rejections in the Final Office Action are therefore improper. Specifically, the Applicant traversed all of the rejections in the Office Action Response filed on March 15, 2006. However, the Final Office Action appears to address only one traversed issue regarding an improper suggestion that one of skill in the art would modify Hamlin to include providing caller ID information to a television. The Final Office Action does not address other traversals relating to, for example, the failure of the cited

references to teach or suggest various claim limitations, and the lack of evidence of motivation for modifying the Hamlin reference. In this regard, the Final Office Action fails to address Applicant's traversals as required. Should any claim rejections be maintained, Applicant requests that the finality of the Office Action mailed on July 11, 2006 be withdrawn, and that the Examiner address Applicant's traversals in the Office Action Response mailed on March 15, 2006.

In view of the above discussion, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. A favorable response is requested. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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